

REMARKS

Claims 1 to 4 and 6 to 33 are currently pending in the present application.

In view of this response, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 1, 4, 7, 9, 13 and 14 were rejected under 35 U.S.C. § 102(b) as anticipated by Ikoma, US Patent No. 5,965,849.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with, to facilitate matters and to better clarify the claimed subject matter, claims 1, 8, 10 and 18 have been rewritten to provide that *the support plate includes a tapered longitudinal section, the expansion measurement transducer being situated in the tapered longitudinal section*. This feature is supported at pages 13 and 14 of the original specification.

The Ikoma reference simply does not identically disclose (or even suggest) this feature. In particular, the Ikoma reference refers to using notch portions outside the sensor section – in contrast to a tapering section in which the transducer is located, as provided for in the context of the presently claimed subject matter. Still further, the Ikoma system is directed

to reducing stress on the plate-like member 7a (Ikoma, column 6). This is in stark contrast to the system of the present application, which involves intensifying the shear stress in the transducer region.

Accordingly, since the applied reference does not identically disclose (or suggest) all of the features of claims 1, 8, 10, and 18, as presented, these claims are allowable, as are their respective dependent claims.

Claims 1 to 3, 7, 9, 10, and 12 to 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over Johansson, U.S. Patent No. 4,280,363, in view of the Ikoma reference.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the rejections may not be agreed with, to facilitate matters and to better clarify the claimed subject matter, claims 1, 8, 10 and 18 have been rewritten to provide that the support plate includes a tapered longitudinal section, the expansion measurement transducer being situated in the tapered longitudinal section. Accordingly, since the applied references do not (and are not even asserted to) disclose or suggest all of the features of claims 1, 8, 10, and 18, as presented, these claims are allowable, as are their respective dependent claims.

Claims 1 to 4, 6 to 11, 13 to 17, and 24 to 33 were rejected under 35 U.S.C. § 103(a) as unpatentable over Jacobson et al., U.S. Patent No. 4,858,475, in view of the Ikoma reference.

Claims 18, 19, 21 and 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over Shiyuuichi, Japanese Patent No. 54-054960 in view of the Ikoma reference.

Claims 20 and 22 were rejected under 35 U.S.C. § 103(a) as unpatentable over Shiyuuichi, Japanese Patent No. 54-054960 in view of the Ikoma reference, and in further view of Jacobson et al., U.S. Patent No. 4,858,475.

While the rejections may not be agreed with, to facilitate matters and to better clarify the claimed subject matter, claims 1, 8, 10 and 18 have been rewritten to provide that the support plate includes a tapered longitudinal section, the expansion measurement transducer being situated in the tapered longitudinal section. Accordingly, since the applied references do not (and are not even asserted to) disclose or suggest all of the features of claims 1, 8, 10, and 18, as presented, these claims are allowable, as are their respective dependent claims.

The Jacobson reference refers to support plates with sensors fastened thereon, but there is no mentioning of any tapering as provided for in the context of the presently claimed subject matter. Also, Jacobson cannot be combined with Ikoma so as to provide the presently claimed subject matter, since Ikoma teaches away from the presently claimed subject matter since it involves intensifying shear forces -- whereas Ikoma involves the relief of stresses by using notches outside of the sensor section.

A combination of Johansson and Ikoma is even more remote from the presently claimed subject matter. In addition to Ikoma teaching away from the presently claimed subject matter, Johansson uses a shaft as a sensing element --instead of a plate-shaped support plate. The shaft in the Johansson system can only be subjected to bending.

In contrast, the presently claimed subject matter involves transforming shear forces directly and more efficiently to an elongation of the transducers.

Finally, Shiyuuichi concerns fitting a partition plate into pipes, presumably for conducting different fluids or for providing a heat exchanger. The Shiyuuichi reference specifically states that “the plate remains fixed as long as no external force acts to the pipe”, so that Shiyuuichi distinctly teaches away from the presently claimed subject matter. The force sensor of the presently claimed subject matter is subjected to deformation to provide a

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measurement. A person having ordinary skill in the art of manufacturing of a sensor would therefore not consider Shiyuichi, since deformation is essential for a force sensor.

Accordingly, the above-discussed claims are allowable for the foregoing reasons.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

In sum, claims 1 to 4 and 6 to 33 are allowable.

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CONCLUSION

It is therefore respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

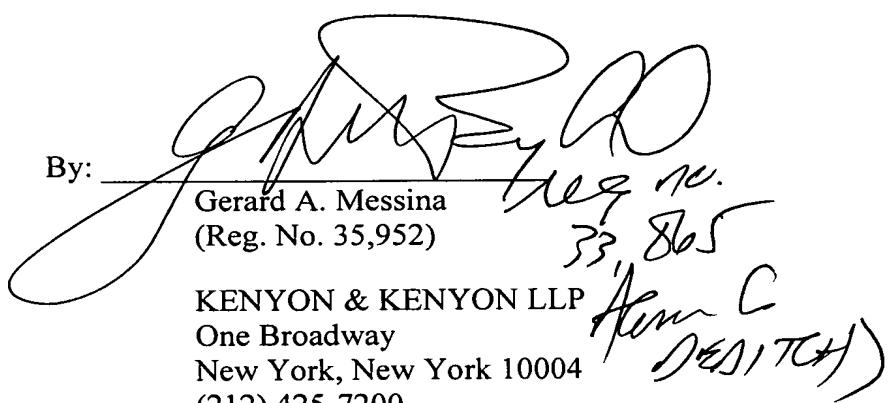
Respectfully submitted,

Dated: 1/19/09

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The image shows a handwritten signature in black ink. The signature appears to read "G. A. MESSINA" followed by "JAN 20 2009" and "33,865". To the right of the signature, there is a handwritten note "Ken C DESITCH".

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